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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,124	08/26/2003	Nobuyuki Saika	16869S-091000US	4758
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TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LE, MICHAEL	
			ART UNIT	PAPER NUMBER
			2163	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/649,124	SAIKA ET AL.
	Examiner	Art Unit
	Michael Le	2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 August 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 3-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 3-10 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 26 August 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/26/03, 4/8/05.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .
5) Notice of Informal Patent Application (PTO-152)
6) Other: ____ .

DETAILED ACTION

Priority

Claims 2-10 have been examined with a priority date of 1/31/2003. Applicant is requested to amend the Specification by adding the claim to foreign priority to Japanese Application No. 2003-025073.

Specification

1. The disclosure is objected to because of the following informalities:
2. Page 15, line 23 “ran” has to be changed to --runs--.
3. Page 16, line 3, “the” has to be changed to --that--.
4. Page 17, line 24, “larger” has to be changed to --smaller--.
5. Page 19, line 25, “ran” has to be changed to --runs--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
7. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

8. Claim 5 recites limitations involving a “second preset capacity” recited in lines 12, 16, 17, 18-19, 22 and 23. Claim 5 further recites limitations regarding storing the acquired performance data in the storage area “if the sum of the calculated performance data capacity and the amount of the existing performance data already stored in the storage area is smaller than the second preset capacity, and deletes some of the existing performance data so that the sum will become the second preset capacity or less and then stores the acquired performance data in the storage area if the sum is larger than the second preset capacity” (lines 14-19). The limitation recited in lines 20-26, recite similar subject matter. The Examiner was unable to determine what portion of the Specification described the limitations of claim 5 in a clear and reasonable manner.

The drawings also did not contain a figure, which coincided with the limitations of claim 5.

Furthermore, a text search for the word “sum” yielded no results in the Specification.

9. As a result of failure to comply with the written description requirement, the Examiner is unable to reasonably interpret the claim to apply prior art. Claim 5 is not addressed in the prior art rejections below.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. The term "substantially" in claim 4, line 18, is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not

provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear to the Examiner the metes and bounds of the meaning of "substantially" as used in the claim.

13. Claim 4 recites the limitation "the capacity" in line 18. There is insufficient antecedent basis for this limitation in the claim. There are several capacities recited in claim 4 such as a performance data capacity, a preset capacity and a capacity to be assigned. It is unclear which capacity is being referenced with the recitation of "the capacity". For the prior art rejections below, the Examiner interprets the limitation to refer to the capacity to be assigned to a performance data area.

14. The prior art rejections below for claims 3, 4, 6-10 are made as best understood in light of the 35 U.S.C. 112, first and second paragraph rejections addressed above.

Claim Rejections - 35 USC § 101

15. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 3-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological art. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

phenomena) that do not apply, involve, use, or advance the technological art fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In *Bowman* (Ex parte *Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished)), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. Although *Bowman* discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea, which is not tied to any technological art or environment.

In the present case, claims 3-10 all recite an abstract idea (e.g. an algorithm or a design) at the preamble; in addition, the steps in the claim body merely recite steps for storing performance data in a storage area, which can be implemented by the mind of a person or by the use of a pencil and paper. For example, with regards to claims 3-8, a storage area could be interpreted as a filing cabinet with a preset number of files that can be stored in it (preset capacity). A controller can be interpreted as a person. The person can perform all the steps in the claim body without the use of a computer. Although a computer system is mentioned in the

preamble of claims 3-8, the computer is not performing the claimed method. In regards to claim 9, once again a controller can be interpreted as a person, which can perform the features of a controller as recited in the claim body. In regards to claim 10, the claim is merely an abstract idea and seems to be software per se, and is not tangibly embodied and therefore nonstatutory.

Since the claimed invention, as a whole, is not within the technological arts as explained above, these claims only constitute an idea and does not apply, involve, use, or advance the technological arts, thus, it is deemed to be directed to non-statutory subject matter.

To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. **Claims 3, 4, 6, 7, 9, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burgess et al. (5,796,633) provided by Applicant in the Information Disclosure Statement filed 4/8/2005, hereinafter “Burgess”, in view of Hasbun et al. (US Patent 6,311,290) hereinafter “Hasbun”, further in view of Voigt et al. (US Patent 5,463,776) hereinafter “Voigt”.**

18. In regards to claim 3, Burgess discloses a data management method for managing performance data of a computer system which includes a storage area for storing the performance data as data including performance information of the computer system and other data (Burgess: Fig. 2, element 36) and a controller for controlling the storage area (Burgess: col. 4, lines 2-7)¹, the method comprising:

- a. a step in which the controller detects free space of the storage area (Burgess: col. 7, lines 11-19);
- b. a step in which the controller acquires the performance data (Burgess: col. 8, lines 19-27); and
- d. a step in which the controller stores the acquired performance data in the storage area (Burgess: col. 8, lines 30-34) wherein the storing step includes:
 - i. a step in which the controller stores the acquired performance data in the storage area if the detected free space is larger than a preset capacity (Burgess: col. 7, lines 11-19; col. 8, lines 30-34)².

19. Burgess does not expressly disclose determining a method for storing the performance data depending on the detected free space and storing the performance data according to the determined method, wherein the storing step includes a step in which the controller deletes performance data already stored in the storage area and then stores the acquired performance data in the storage area if the detected free space is smaller than the preset capacity.

¹ Monitoring and tracking agent is interpreted as a controller for controlling the storage area because it stores the data and performs other tasks in accordance with the storage, such as notification of other modules.

² The amount of free spaced is detected and if it is larger than the preset capacity (5%), then storage continues and the performance data is stored in the disk drives (storage area).

20. Hasbun discloses determining a method for storing data depending on the detected free space and storing the data according to the determined method (Hasbun: col. 26, lines 12-24). Hasbun also discloses determining the capacity of the data to be stored and a storing step that includes, when the detected free space is greater than the capacity of the data to be stored, the data is stored and when the detected free space is less than the capacity of the data to be stored, as much of the data is stored to the space as possible until more space can be reclaimed, at which time more of the data is stored as space becomes available (Hasbun: col. 26, lines 25-34; col. 27, lines 3-20).
21. Voigt discloses a space manager for managing the storage area by determining if the amount of free space available below a predetermined lower threshold level, in which case the space manager will attempt to create free space until the amount of free space is equal to an upper threshold amount of free space (Voigt: col. 4, lines 40-55). Voigt further discloses that free space can be created by deleting old files (Voigt: col. 4, lines 34-37).
22. Burgess, Hasbun and Voigt are analogous art because they are from the same field of endeavor of data and storage management.
23. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the method of Burgess by adding the step of determining a method for storing performance data depending on the detected free space and storing the performance data according to the determined method, wherein the storing step includes a step in which the controller deletes performance data already stored in the storage area and then stores the acquired performance data in the storage area if the detected free space is smaller than the preset capacity.

24. The motivation for doing so would have been because data storage space has a finite capacity, therefore continuous storage into a finite space needs to be managed as dependent on the amount of free space available in the storage device in order to efficiently utilize the space available (Voigt: col. 1, lines 26-51).

25. In regards to claim 4, the limitations are substantially similar to claim 3 except for the addition of the steps of calculating a performance data capacity necessary for recording the acquired performance data in the storage area and the step of if the detected free space is smaller than the preset capacity, in which the controller assigns a capacity to a performance data area for storing the performance data so that the capacity will be substantially the same as the amount of existing performance data already stored in the storage area, deletes some of the existing performance data so that the amount of the existing performance data will be reduced by at least the calculated performance data capacity, and stores the acquired performance data in the storage area. These steps were addressed in the rejection to claim 3 as being disclosed by Hasbun. Hasbun discloses determining the capacity of the data to be stored and a storing step that includes, when the detected free space is greater than the capacity of the data to be stored, the data is stored and when the detected free space is less than the capacity of the data to be stored, as much of the data is stored to the space as possible until more space can be reclaimed, at which time more of the data is stored as space becomes available (Hasbun: col. 26, lines 25-34; col. 27, lines 3-20).

26. In regards to claim 6, the limitations have been addressed in the rejections to claims 3 and 4 above.

27. Claim 7 recites substantially the same limitations as claim 4 and is therefore rejected for the same reasons.

28. Claim 9 recites substantially the same limitations as claims 3 and 4 in the form of a controller performing the method steps and is therefore rejected for the same reasons.

29. Claim 10 recites substantially the same limitations as claims 3 and 4 in the form of a program for a controller performing the method steps and is therefore rejected for the same reasons.

30. **Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burgess et al. (5,796,633) provided by Applicant in the Information Disclosure Statement filed 4/8/2005, hereinafter “Burgess”, in view of Hasbun et al. (US Patent 6,311,290) hereinafter “Hasbun”, further in view of Voigt et al. (US Patent 5,463,776) hereinafter “Voigt”, further in view of Fisher et al. (US Patent 5,943,688) hereinafter “Fisher”.**

31. Burgess, Hasbun and Voigt disclose the limitations of parent claim 7 as addressed above.

32. Burgess, Hasbun and Voigt do not expressly disclose making a backup of all or part of the deleted performance data before the deletion of the existing performance data.

33. Fisher discloses backing up a current database when it is detected that the database is full and there is no more available free memory (Fisher: fig. 5A; col. 7, lines 62-67; col. 8, lines 1-24).

34. Burgess, Hasbun, Voigt and Fisher are analogous art because they are from the same field of endeavor of data storage and management.
35. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the method of Burgess, Hasbun and Voigt by adding the step of making a backup of all or part of the deleted performance data before the deletion of the existing performance data.
36. The motivation for doing so would have been because it is advantageous to create a backup copy of files that are to be deleted in the case that the files need to be recovered for some reason or if a failure occurs to the current storage device, the backup can be used (Fisher: col. 1, lines 56-65).

Conclusion

37. The following are prior art made of record and not relied upon but is considered pertinent to applicant's disclosure.
38. Kimpara et al. (US patent 4,924,745) discloses an automatic performance recording apparatus. Wakamiya et al. (US Patent 5,611,047) discloses a method of transferring information even if the storage unit has insufficient space for storing the information. Arataki et al. (US Patent 5,774,434) discloses a method and apparatus for recording data on and deleting already recorded data from a recording medium. Rodriguez et al. (US Patent 6,725,241) discloses a method and apparatus for freeing memory in a data processing system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Le whose telephone number is 571-272-7970. The examiner can normally be reached on Mon-Thurs : 9:30am-6pm, Fri: 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML



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PRIMARY EXAMINER